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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/443,702	11/19/1999	JAMES P. DOURISH	XER-2-299	7610

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ALBERT P SHARPE III ESQ
FAY SHARPE FAGAN MINNICH & MCKEE LLP
1100 SUPERIOR AVENUE
7TH FLOOR
CLEVELAND, OH 441142518

EXAMINER

NGUYEN, MAIKHANH

ART UNIT

PAPER NUMBER

2176

DATE MAILED: 04/20/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/443,702

Applicant(s)

DOURISH, JAMES P.

Examiner

Maikhanh Nguyen

Art Unit

2176

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 June 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9 and 19-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9 and 19-22 is/are rejected.
- 7) ☒ Claim(s) 23 and 24 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This action is responsive to communications: Response to Restriction Requirement filed 06/07/2004 to the original application filed 11/19/1999.
2. Claims 1-9 and 19-24 are currently pending in this application. Claims 10-18 have been canceled. Claims 22-24 have been added. Claims 1 and 19 are independent claims.
3. Applicant's election of group I (claims 1-9 and 19-21), filed June 7, 2004 is acknowledged. Because Applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-9 and 19-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Levine et al.** (U.S. 6,167,439 – filed 11/1993) in view of **Wang et al.** (U.S. 5,848,426 – filed 02/1996).

As to independent claim 1:

- a. Levine teaches a method of providing an active annotation mechanism for use in association with a document of a document management system, where the document has an annotation added (*a document to be annotated may be chosen from the user's system desk...Annotations may be made as with any other document through the stylus, keyboard and audio input/output assembly; col.4, lines 3-30*), the method comprising:
- (i) electronically scanning the document (*e.g., scanning the document into the system; col.8, lines 44-49*);
 - (ii) detecting the annotation added to the scanned document (*e.g., detects ... in new data ... having inserted all desired annotations; col.38, lines 10-42*);
 - (iii) examining content of the annotation (*col.38, lines 57-67*);
 - (iv) determining an action to be undertaken with reference to the document, based on content of the annotation; and performing the action required by the annotation (*provides a limited number of optional actions that the user select ...the "playback" option displays the initial form of the current document at its original followed by a time sequence of the annotations made to the document up through and including the present annotation session; col.5, lines 22-44*).
- b. Levine does teach decoding (*e.g., decoder; col.37, lines 24-63*); however, does not specifically teach "decoding the detected annotation."

- c. Wang teaches decoding the detected annotation (*e.g., encoder will encode the annotation and other identification/content information; col.6, lines 8-51*).
- d. It would have been obvious to one of ordinary skill in the art at the time the invention was made to include the feature from Wang in the system of Levine because it would have provided the capability for allowing automatic translation of an annotation and enabling user to take an appropriate action based on the content of the annotation.

As to dependent claim 2:

- a. Levine teaches the annotation is detect by an active annotation mechanism configured to be aware of a nature of the of the annotation content and applications whose behavior is coordinated to perform the action required by the annotation (*col.40, line 60-col.41, line 3*). However, Levin does not specifically teach “operation of the inactive annotation mechanism permits performance of the action required by the content of the annotation without user intervention.”
- b. Wang teaches operation of the inactive annotation mechanism permits performance of the action required by the content of the annotation without user intervention (*col.6, lines 1-7*).
- c. It would have been obvious to one of ordinary skill in the art at the time the invention was made to include the feature from Wang in the system of Levine because it would have provided the capability for allowing automatic translation of an annotation and enabling user to take an appropriate action based on the content of the annotation.

As to dependent claim 3:

Levine teaches the active annotation mechanism is invoked when the document is stored (*col.6, lines 33-63*).

As to dependent claim 4:

Levine teaches the active annotation mechanism is invoked at predetermined time intervals (*col.6, lines 33-42*).

As to dependent claim 5:

Levine teaches the annotation carries at least one of an activity to be carried out and a parameter that configures that activity (*col.54, lines 1-29*).

As to dependent claim 6:

Levine teaches the annotation is stored with the document (*e.g., Annotations may be made as with any other document; col.4, lines 17-30*)

As to dependent claim 7:

Levine teaches the annotation is stored separate from the document (*col.26, lines 37-67*).

As to dependent claim 8:

Levine teaches the active annotation mechanism operates over at least plain text, files, program source code and presentations (*col.19, lines 20-52 & col.21, lines 13-32*).

As to independent claim 19:

It is directed to an active annotation mechanism for performing the method of claim 1, and is similarly rejected under the same rationale.

As to dependent claim 22:

Levine teaches document management system is configured to dynamically change a system configuration of the document (*col.42, lines 1-35*).

As to dependent claim 21:

Refer to discussion of claim 2 above for rejection.

5. Claim 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over **Levine et al.** in view of in view of **Wang et al.** as applied to claim 19 above, and further in view of **Applicant's Admitted Prior Art (APA)**.

As to dependent claim 20:

- a. The combination of Levine and Wang does not specifically teach "the annotation is placed on the document at least one of an in-line annotation and an out-of-band annotation."
- b. APA teaches the annotation is placed on the document at least as an in-line annotation and an out-of-band annotation (*e.g., Annotations are provided in a variety of ways, including but not limited to in-line annotation, or out-of-band annotations; Specification, page 1*).
- c. It would have obvious to a person of ordinary skill in the art at the time the invention was made to combine the teachings of APA with Levine because it would have provided the enhanced capability for adding comments to a document.

Allowable Subject Matter

6. Claims 23-24 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Response to Arguments

7. Applicant's arguments filed 06/07/2004 have been fully considered but they are not persuasive.
- a. Applicant argues that *there is no teaching or and detecting any added annotations in Levine*. (Remarks, page 7)
 - b. In response, the rejection above shows how the teachings of the newly applied prior art (Wang) meet the claim limitations.
 - c. As to dependent claims 2-9 and 20-22 the arguments are not persuasive for reason as discussed above with regards to independent claims 1 and 19.

Conclusion

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Kanerva et al. U.S. Patent No. 6,122,649 issued: Sep. 19, 2000

Morton U.S. Patent No. 6,438,564 issued: Aug. 20, 2002

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).
A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action
10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Maikhanh Nguyen whose telephone number is (571) 272-4093. The examiner can normally be reached on Monday - Friday from 9:00am – 5:30 pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph H Feild can be reached on (571) 272-4090.
The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Maikhanh Nguyen
April 18, 2005


JOSEPH FEILD
SUPERVISORY PATENT EXAMINER